

## REMARKS

This application has been reviewed in light of the Office Action dated January 31, 2005.

In response, Claims 18, 23-26, and 28-38 have been amended to overcome formal objections thereto, the second paragraph of the Claim 27 has been amended to overcome a substantive rejection, Claims 18, 20, 22, 23, 27-36, and 38 have been amended for reasons unrelated to patentability to improve their form, and Claims 39-44 have been added to afford Applicants the full scope of protection to which they are entitled. Accordingly, Claims 18-44 are pending. Claims 18, 22, and 27 are independent. Favorable reconsideration is requested.

### *Formal Claim Objection*

Claims 18, 23-26, and 28-38 have been objected to for alleged minor informalities therein and the Examiner suggests specific amendments for overcoming the objections. In response, while not conceding the propriety of the objections and solely to advance prosecution and reduce the number of outstanding issues, Applicants have amended these claims as suggested by the Examiner, thereby rendering the objections moot.

### *Formal Claim Rejection*

In paragraphs 2 and 3 of the Office Action, Claim 22 is rejected under 35 U.S.C. § 112, second paragraph, “as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.” In particular, the Office Action states that “[t]he omitted steps are: positioning the mechanical bezel through the opening in the panel, and

then positioning the optical coupler within the housing of the bezel. According to the present specification, the external device and the module are not connected to each other directly. They are connected to each other through the bezel, which provides communication connection between the external device and the module without substantially disrupting operation of the module. Therefore, connecting the external device with the module without the bezel can disrupt the operation of the module.”

Applicants respectfully disagree at least for two reasons.

First, the test for determining whether essential steps are omitted from a claim under MPEP § 2172.01 has not been satisfied in this case. This section of the MPEP permits the Patent Office to reject a claim for omitting essential steps where the specification states that those steps are essential:

[A] claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph. (Manual of Patent Examining Procedure, Original Eighth Edition, May 2004 Revision, page 2100-204, right column)

But here, the specification never states that the bezel is essential to perform this connecting function. Nor does the Office Action identify the portion of the specification requiring the bezel to perform the connecting function. In fact, page 8, lines 24 through 27 of the specification indicates that the structures described therein are merely illustrative: “It is to be understood that the above-described arrangements are simply illustrative of the invention. Other arrangements may be devised by those skilled in the art which will embody the principles of the invention and fall with the spirit and scope thereof.” Therefore, for this reason alone, the Patent Office has not

satisfied its burden of proof to reject Claim 22 for failing to satisfy 35 U.S.C. § 112, second paragraph.

Second, the Office Action's argument is logically flawed. The Office Action argues that 1) because the bezel permits external-device communication without substantially disrupting the module's operation, 2) a bezel connecting step must be claimed. But, conclusion 2) does not necessarily follow from assumption 1). A teaching that the bezel facilitates communication without disrupting the module, does not imply that communication without the bezel *necessarily* disrupts the module. Nor does the specification teach or suggest such a concept. Rather, the specification merely states at page 4, lines 15-18 that "[t]he bezel according to the present invention is positioned within the opening and facilitates the optical connection between the connector and the external device". Without any evidence that bezel-less communication necessarily disrupts the module, it is logically improper to conclude that a bezel is essential for the invention of Claim 22. Therefore, the Office Action has, for this additional reason, failed to satisfy its burden of proof to reject Claim 22 under 35 U.S.C. § 112, second paragraph.

If the Examiner is not persuaded to withdraw this rejection in view of the foregoing remarks, he is respectfully requested to identify the portion of the specification stating that the use of the bezel is necessary or essential to the invention, as required by MPEP 2172.01.

#### *Anticipation Rejection*

Claims 22-24, 27-32, 34, 35, and 37 are rejected under 35 U.S.C. § 102(e) over U.S. Patent No. 6,186,670 (Austin et al.).

This rejection is respectfully traversed at least for the following reasons.

Independent Claim 22

Claim 22 relates to a method for optically coupling an optical attenuator to a communication module disposed on an internal side of a panel. The method comprises the steps of optically coupling an optical coupler to the communication module through an opening in the panel that provides access from an external side of the panel to the communication module, and optically connecting an end of the optical attenuator to the optical coupler, to thereby optically couple the optical attenuator to the communication module through the optical coupler.

By this arrangement, different attenuators required to connect different external devices to a communication module inside a panel can be easily attached between such external devices and the communication module.

In contrast, the patent to Austin et al. is not understood to show an optical attenuator. As a result, this patent is not understood to disclose or suggest the step of optically connecting an end of an optical attenuator to an optical coupler, to thereby optically couple the optical attenuator to a communication module through the optical coupler, as recited in Claim 22.

Moreover, the Office Action admits that the Austin et al. patent does not teach the use of an optical attenuator. Paragraph 7 of the Office Action, in discussing the types of external devices that the Austin et al. patent discloses as being usable with his module 10, observes: "Austin does not state that the external device is an optical attenuator."

Since the Austin et al. patent is not understood to disclose at least one feature of Claim 22, and since the Office Action admits as such, the Patent Office has not yet satisfied its burden of proof to establish anticipation of Claim 22 over this patent. Therefore, Claim 22 is believed to be patentable over the Austin et al. patent.

#### New Dependent Claim 43

New dependent Claim 43 depends from Claim 23, which in turn, depends from Claim 22. Claim 43 is understood to be allowable over the Austin et al. patent for the reasons that Claim 22 is allowable and because it recites features not understood to be disclosed or suggested by the Austin et al. patent. Claim 43 recites the positioning of the optical coupler within a housing of a mechanical bezel through a first end of the housing, and the connecting of the end of the optical attenuator to the optical coupler at or through a second end of the housing, opposite from the first end. Support for these features is found at least in Figures 1 and 2, at page 5, lines 5 through 10 of the specification, as amended in the February 10, 2004 Preliminary Amendment, and at page 8, lines 15-22 of the specification. In contrast, the patent to Austin et al., is understood to disclose that all of the elements insertable into the module 10 — the connectors 100 and 110 and the adapter 120 — are inserted into the module 10 from the same end, i.e., the front opening 23. Therefore, this claim is understood to be allowable over the Austin et al. patent for these reasons.

### Independent Claim 27

Claim 27 relates to a mechanical bezel, comprising a first, housing portion having an inner channel extending in the direction of a line connecting first and second open ends of the first, housing portion, and a second portion extending from the first open end of the first, housing portion, and being adapted to couple the mechanical bezel to a communication module disposed on an internal side of the panel, so that the first open end is closer to the communication module than the second open end when at least a portion of the mechanical bezel is inserted at least partially through the opening of the panel. Support for the added closer-to-the-module feature is found at least in Figures 1 and 2 and at page 6, line 16 through page 8, line 22 of the specification.

By this arrangement, the bezel need not be positioned deeply into the panel to couple to the module, since the portion that couples to the module extends from the end of the housing that is closer to the module upon insertion into the panel.

In contrast, Figure 9 of the Austin et al. patent is understood to merely show the connecting of a panel 66 to the middle portion and the far end 23 of a module 10 (*farthest* from the module within the panel 66). This patent is not understood to show the coupling of a bezel to a communication module on the internal side of a panel via a portion extending from an end of a housing portion *closest* to the communication module, as recited by amended Claim 27. More specifically, the Austin et al. patent is understood to teach the use of a slot 76 of a locking flange 60 and a slot 88 of a top wall 14 to attach the module 10 to opposing outer wall surfaces 69 of the panel 66 (column 10, line 65 through column 11, line 47). As shown in Figures 2, and 9, the end

of the module 10 closest to the module in the panel 66 is the back opening 25, which extends through the cutout 62 of the panel 66. Slots 76 and 88 do not extend from this end 25. Rather, the slot 76 of the flange 60 extends from the front opening 23 disposed on the opposite side of the module 10 from the back opening 25. And the slot 88 appears to be positioned at the midpoint of the top wall 14 between the back opening 25 and the front opening 23. Thus, these panel-attaching portions do not extend from an end of a housing that is closest to a module on the internal side of the panel 66. In addition, the Office Action does not allege that these elements extend from the end of the module 10 closest to a module on the internal side of the panel 66.

Since the Austin et al. patent is not understood to disclose at least one feature of Claim 27, and since the Office Action fails to allege that the Austin et al. patent includes the above-discussed feature, the Patent Office has not yet satisfied its burden of proof to establish anticipation of Claim 27 over this patent. Therefore, Claim 27 is believed to be patentable over the Austin et al. patent.

#### New Dependent Claim 44

Dependent Claim 44, which depends from Claim 27, has been added. Claim 44 is understood to be allowable over the Austin et al. patent at least for the reasons that Claim 27 is allowable and because it recites features not understood to be disclosed or suggested by the Austin et al. patent. Claim 44 recites that the first housing portion comprises two opposed side walls, the interior portion of each of which comprises a guiding member. Claim 44 also recites that the guiding members form the inner channel recited in Claim 27. Support for these features

is found at least in Figure 1, and at page 5, lines 17 through 20 of the specification, as amended in the February 10, 2004 Preliminary Amendment. On the other hand, the patent to Austin et al., is understood to disclose merely that the connector 100 and the adapter 120 are guided and positioned within the module 10 by structures on the top wall 14 and the bottom wall 16. This patent is not understood to disclose or suggest the use of guiding members on the interior of two opposed side walls forming an inner channel, as recited by Claim 44. For these reasons, Claim 44 is understood to be allowable over the Austin et al. patent.

#### *Obviousness Rejection*

Claims 18-21, 25, 26, 33, 36, and 38 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,186,670 (Austin et al.) in view of U.S. Patent No. 6,447,172 (Stephenson et al.).

This rejection is respectfully traversed at least for the following reasons.

#### Independent Claim 18

Independent Claim 18 relates to a bezel for facilitating connection between an external device positioned on one side of a communication panel and a module located on an opposite side of the communication panel, the communication panel having an opening for receiving the bezel. The bezel comprises a housing and the housing defines an interior portion. The bezel also comprises a first open end insertable into the module through the opening. The first open end is positioned and configured to receive a first communication connection of the module for connection with the external device. The bezel also comprises a second open end having an



openable cover. The second open end is configured to receive at least a second communication connection of the external device for connection with the first communication connection when the openable cover is open, without substantially disrupting operation of the module. The interior portion is configured to house an optical coupler for connecting the first communication connection of the module to the second communication connection of the external device.

By this arrangement, the connection between the bezel and the module can be easily confirmed, since the bezel is connected directly to the module.

In contrast, the patent to Austin et al. is understood to merely show an optical fiber connection module 10 that is connected by a slot 88 in its top wall 14 and a slot 76 in its flange 60 to outer surfaces 69 of a panel 66, as shown in Figures 8 and 9 and as discussed at column 10, line 66 through column 11, line 47. No module inside the panel 66 is shown, and no part of the module 10 is understood to be disclosed to be insertable into such a module inside the panel 66. Therefore, this patent is not understood to disclose or suggest a bezel comprising a first open end insertable into a module located on an opposite side of a panel from an external device, as recited by amended Claim 18.

Similarly, the patent to Stephenson et al. is not understood to disclose or suggest a bezel comprising a first open end insertable into a module located on an opposite side of a panel from an external device, as recited by amended Claim 18. Rather, this patent is understood to disclose a first fiber-optical-connector-receiving element — a buildout cap 32 — whose latching arrangement 43 snap fits onto a buildout base 10 attached to a mounting panel 97, and a second fiber-optical-connector-receiving element — the buildout base 10 — that is connected to the

mounting panel 97 by flanges 21 and 22 (column 5, line 31 through column 7, line 54). The buildout base 10 has an opening 27 for receiving an optical fiber connector (column 6, lines 51-55), and the buildout cap 32 includes an alignment sleeve holder 70 (column 8, lines 51-60 and column 11, lines 7-53). When an attenuator 90 is positioned in the holder 70 and the cap 32 is mounted on the base 10, the attenuator 90 connects a fiber optical connector received in the cap (from outside the panel 97) and a fiber optical connector received in the base (from inside the panel) (Figure 6, and column 11, lines 27-42). Thus, one end of the cap 32 is understood to be inserted into the base 10, rather than a module on the opposite side of the panel from an external device. And one end of the base 10 is understood to be inserted into the panel 97, rather than a module on the opposite side of the panel from an external device. Therefore, neither of these elements is understood to comprise a bezel comprising a first open end insertable into a module located on an opposite side of a panel from an external device, as recited by amended Claim 18.

Moreover, paragraph 7 of the Office Action fails to address this issue. More specifically, the Office Action never identifies a portion of either the Austin et al. patent or the Stephenson et al. patent that shows a bezel insertable into a module located on an opposite side of a panel from an external device, as recited by amended Claim 18. Nor does the Office Action even allege that these references disclose this feature.

These omissions of the Office Action prove fatal to establishing a prima facie case of obviousness against Claim 18 under MPEP § 2142, since this portion of the MPEP requires the Patent Office to cite art showing each claimed feature:

To establish a prima facie case of obviousness . . . the prior art reference (or references when combined) must teach or suggest all

the claim limitations. (Manual of Patent Examining Procedure, Original Eighth Edition, May 2004 Revision, page 2100-128, right column)

For this reason alone, the Patent Office has failed to establish a prima facie case of obviousness against Claim 18.

Moreover, the Office Action is understood to have failed to establish a prima facie case of obviousness against Claim 18 for two additional reasons.<sup>1</sup>

First, the Office Action is not understood to have established a legally sufficient motivation to combine the references to produce the invention of Claim 18, as also required by MPEP § 2142. This portion of the MPEP also states:

To establish a prima facie case of obviousness . . . there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings . . . . The teaching or suggestion to make the claimed combination . . . . must . . . be found in the prior art, and not based on applicant's disclosure.

. . .

With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a prima facie case of obviousness) is more probable than not. (Manual of Patent Examining Procedure,

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<sup>1</sup>/These reasons involve the Office Action's failure to articulate a legally sufficient motivation to add the Stephenson et al. attenuator to the Austin et al. module and the failure to establish a reasonable expectation of success in doing so. But the Office Action's obviousness argument on the attenuator issue is moot because the attenuator feature has now been deleted from Claim 18. Nevertheless, Applicants discuss these aspects of the Office Action to make of record Applicants' disagreement with the Office Action's position on the obviousness of Claim 18 at the time the Office Action issued.

Here, paragraph 7 of the Office Action provides the rationale for combining the references to produce the invention of Claims 18: “It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the external device taught by Austin such that it would be an attenuator as taught by Stephenson in order to modify an optical signal. Also, the attenuator is well known in the art of an optical fiber.”

But, the Office Action identifies no portion of either reference or generally available knowledge suggesting the desirability of using an attenuator in a coupler that is configured to connect SC style and FC style connectors 100 and 110 via an FC-SC optical adapter 120 to a module inside a panel (e.g., the Austin et al. coupler 10). Nor does the Office Action suggest why it would be desirable to modify an optical signal with an attenuator in a coupler connecting SC style and FC style connectors. Thus, the Patent Office has not established that it is more probable than not that the skilled artisan would be motivated to add an attenuator to the Austin et al. coupler 10. Without any evidence of such a motivation, the Office Action’s argument becomes this: since the references can be combined, the resulting combination is obvious. But, such reasoning is prohibited under MPEP §2143.01, which states that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination”. (emphasis in the original) (Manual of Patent Examining Procedure, Original Eighth Edition, May 2004 Revision, page 2100-131) For these additional reasons, the Patent Office has not established a prima facie case of obviousness against Claim 18.

Second, the Office Action fails to establish that there would be a reasonable expectation of success in combining the two references, as also required by MPEP § 2142. This portion of the MPEP also states:

To establish a prima facie case of obviousness . . . there must be a reasonable expectation of success. . . . The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (Manual of Patent Examining Procedure, Original Eighth Edition, May 2004 Revision, page 2100-128, right column)

Here, the Office Action has not provided any evidence that an optical attenuator could be successfully coupled to the FC-SC optical adapter 120, designed to connect to FC style and SC style connectors 100 and 110, within the connector module 10 described in the Austin et al. patent. As a result, the Patent Office has not established a reasonable expectation of success or that success would be more probable than not, in combining the references to produce the claimed invention, as required by MPEP § 2142. Accordingly, for this additional reason, the Patent Office has not established a prima facie case of obviousness against Claim 18.

Applicants have also added four dependent claims, dependent on Claim 18, that are understood to be allowable over the Austin et al. and Stephenson et al. patents at least for the reasons that Claim 18 is allowable and because they recite features not understood to be disclosed or suggested by these patents.

#### New Dependent Claim 39

Claim 39 recites that the interior portion is configured to permit entry of the optical coupler through the first open end, insertable into a module located on the opposite side of a communication panel from an external device. Support for this feature is found at least in Figure 1 and at page 5, lines 5 through 10 of the specification, as amended in the February 10, 2004 Preliminary Amendment. The Austin et al. patent, on the other hand, is understood to show the entry of the SC connector 100, the FC connector 110 and the adapter 120 through the end of the module 10 that is not inserted into the panel 66. In addition, the Stephenson et al. patent is not understood to show insertion of the alignment sleeve holder 70 through an open end of a bezel that is insertable into a module, since the end of the cap 32 is disclosed to snap fit into the base 10 rather than a module, as discussed above.

#### New Dependent Claims 40 and 41

Claim 40 recites that the first open end includes a plurality of projecting members insertable into the module, each projecting member including an end having an inclined portion ending in a shoulder portion, the inclined portion and the shoulder portion forming at least a portion of a cam surface. Claim 41 recites that at least part of the cam surface substantially locks the housing to the module, thereby maintaining at least a portion of the optical coupler in a position within the interior of the housing. Support for these features is found at least in Figures 1 and 2, and at page 6, lines 15 through 25 of the specification as amended in the February 10, 2004 Preliminary Amendment. In contrast, neither the Austin et al. patent nor the Stephenson et

al. patent is understood to disclose or suggest any structure insertable into a module located on an opposite side of a communication panel from an external device, as discussed above. Therefore, these patents are not understood to disclose or suggest the use of such a plurality of projecting members or a cam surface, as recited by dependent Claims 40 and 41.

#### New Dependent Claim 42

Claim 42 recites that the housing includes a longitudinally extending open portion configured to permit a tab of the optical coupler to pass therethrough beyond the exterior of the housing. Claim 42 also recites that the housing includes an edge defining the end of the longitudinally extending open portion and engageable with the tab of the optical coupler when the optical coupler is inserted through the first open end. Support for these features is found at least in Figure 1 and at page 5, lines 5 through 10 of the specification, as amended in the February 10, 2004 Preliminary Amendment. In contrast, the external side walls 18 of the module 10 shown in the Austin et al. patent are not understood to permit any structure of the connectors 100 and 110 or the adapter 120 to pass therethrough. Therefore, this patent is also not understood to disclose or suggest that the module 10 has an edge engageable with a tab passing through an open portion beyond the external side walls 18. Similarly, the Stephenson et al. patent is also not understood to disclose or suggest any such open portion of a bezel insertable into a module, permitting a tab on an optical connector to pass therethrough.

The other rejected claims in this application depend from one or another of the independent claims discussed above, and therefore, are submitted to be patentable for at least the

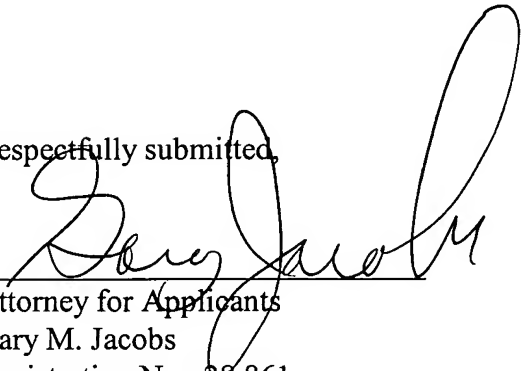
same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each dependent claim on its own merits is respectfully requested.

*Conclusion*

In view of the above amendments and remarks, the application is now in allowable form. Therefore, early passage to issue is respectfully solicited.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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